

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,957	<b>Applicant(s)</b> KUDRA ET AL.	
	<b>Examiner</b> NANCY BITAR	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

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|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. <u>11/01/2009</u> .                         |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application  |
| Paper No(s)/Mail Date <u>5/10/2006</u> .   | 6) <input type="checkbox"/> Other: _____.                          |

### DETAILED ACTION

1. The Non-final rejection dated 9/23/2009 has been VACATED .

The error noted by applicant representative that the claims used in the rejection dated 9/23/2009 are not the claims belonging to the PCT/US2004/38044 but rather it belongs to PCT/US2004/39044 .Examiner fixed the error and below is the rejection for the instant application.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 14-20 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. The Federal Circuit<sup>1</sup>, relying upon Supreme Court precedent<sup>2</sup>, has indicated that a statutory “process” under 35 U.S.C. 101 must (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. This is referred to as the “machine or transformation test”, whereby the recitation of a particular machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility (See *Benson*, 409 U.S. at 71-72), and the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity (See *Flook*, 437 U.S. at 590”). While the instant claim(s) recite a series of steps or acts to be performed, the

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<sup>1</sup> *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

<sup>2</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

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claim(s) neither transform an article nor are positively tied to a particular machine that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

NOTE: Regarding the rejection of claims 14-20, please see the Memorandum dated May 15, 2008, "Clarification of Processes under 35 USC § 101" which may be viewed at the following web address:

[http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section101\\_05\\_15\\_2008.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section101_05_15_2008.pdf)

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 1-4, 6-10 and 13-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Kenet et al (U.S. Patent 5,291,889), in view of Imran et al (U.S. Patent 6,251,073).**

With regard to claim 1, Kenet discloses plural digital images showing the skin of a patient (see col. 4, lines 1-24); and a software application (computer system) adapted for managing said plural digital images by facilitating viewing said plural digital images (see col. 4, lines 19-24) in a range of resolutions (manipulation and enhancement of the

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image) and in a sequence (reads on image frame), said plural digital images (see Fig. 3, item 36).

Kenet does not explicitly call for software application being carried on portable memory storage device, However, in the same field of endeavor, Imran teaches this feature (see col. 12, lines 63-67). At the time of the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Imran portable memory storage device into Kenet system. The suggestion/motivation for doing so would have been to store image data into a portable memory storage device (see col. 12, lines 63-67). Therefore, it would have been obvious to combine Imran with Kenet to obtain the invention as specified in claim 1.

With regard to claim 2, Kenet is silent about wherein said portable memory storage device is a compact disk. However, in the same field of endeavor, Imran teaches this feature (see col. 12, lines 63-67). At the time of the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Imran portable memory storage device into Kenet system. The suggestion/motivation for doing so would have been to store image data into a portable memory storage device (see col. 12, lines 63-67). Therefore, it would have been obvious to combine Imran with Kenet to obtain the invention as specified in claim 2.

With regard to claim 3, Kenet discloses wherein said each digital image has at least six million pixels (see col. 4, lines 22-27).

With regard to claim 4, Kenet discloses wherein said plural digital images include plural sets of digital images, each set of said plural sets of digital images showing the

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skin of said patient, and wherein said software application is further adapted to permit comparison of said plural sets of digital images so that a user can look for changes over time in moles present on the skin (see col. 4, lines 1-26).

With regard to claim 6, Kenet discloses a memory adapted to store plural digital images showing the skin of a patient (see col. 4, lines 28-32); and a software application in communication with said memory and adapted to retrieve digital images from said plural digital images when said plural digital images are stored in said memory (see col. 4, lines 19-24), said software application having a graphical user interface that enables a user to view said plural digital images (see col. 4, lines 25-27), means for displaying said plural digital images in a range of magnifications (see col. 2, lines 39-43), means for selecting portions of said plural digital images for display (see col. 2, lines 23-26), and means for annotating said plural digital images when said plural digital images are stored in said memory (see col. 2, line 32-38).

With regard to claim 7, Kenet discloses wherein said software application permits comparison of images of said plural digital images (see col. 4, lines 27-32).

With regard to claim 8, Kenet discloses wherein said software application is adapted to receive annotations to images of said plural digital image (see col 2, lines 32-38).

With regard to claim 9, Kenet discloses wherein said software application is adapted to display said plural digital images with annotations (see col. 4, lines 19-24).

With regard to claim 10, Kenet discloses wherein said software application includes means for acquiring additional digital images and adding said additional images to said memory (see col. 4, lines 19-24).

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With regard to claim 13, Kenet discloses wherein said memory is dimensioned to hold at least one set of 33 digital images, each image of said 33 images containing at least six million pixels (see col. 4, lines 19-26).

Claim 14 is similarly analyzed and rejected the same as claims 1 and 6.

With regard to claim 15, Kenet discloses further comprising the steps of: making a second set of plural digital images of the skin of said patient, images of said second set corresponding to images of said second set to define image pairs; storing said second set of plural digital images in said digital memory device; and comparing said first set to said second set of digital images to determine if there are changes in moles present on the skin of said patient (see col. 4, lines 28-32).

With regard to claim 16, Kenet discloses wherein said comparing step further comprises the step of comparing image pairs side by side (see col. 4, lines 28-32).

With regard to claim 17, Kenet discloses wherein said comparing step further comprises the step of comparing corresponding image pairs by overlaying said images of said first set with images of said second set (see col. 4, lines 46-50).

With regard to claim 18, Kenet discloses wherein said making step further comprising the step of making each digital image substantially normal to the skin of said patient (see col. 3, lines 30-39).

Claim 19 is similarly analyzed and rejected the same as claim 13.

With regard to claim 20, the step of installing a software application on said digital memory device, said software application having a graphical user interface and being adapted for managing said first set of plural digital images (see col. 4, lines 19-27).

***Claims 5, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenet et al (U.S. Patent 5,291,889) and Imran et al (U.S. Patent 6,251,073), and further in view of Killcommons et al (U.S. Patent 6,424,996).***

With regard to claim 5, Kenet and Imran are silent about wherein said range of magnification is up to 3200%. However, in the same field of endeavor, Killcommons teaches this feature (see col. 13, lines 64-67). At the time of the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Killcommons image magnification process into Kenet system. The suggestion/motivation for doing so would have been to provide the process of selecting percentage of zooming (see col. 13, lines 59-67). Therefore, it would have been obvious to combine Killcommons with Kenet to obtain the invention as specified in claim 5.

With regard to claim 11, Kenet and Imran are silent about wherein said software application includes means for encrypting said plural digital images. However, in the same field of endeavor, Killcommons teaches this feature (see col. 4, lines 5-9). At the time of the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Killcommons image magnification process into Kenet system. The suggestion/motivation for doing so would have been to provide the process of selecting percentage of zooming (see col. 13, lines 59-67).

With regard to claim 12, Kenet and Imran are silent about means for reversing said plural digital images so that a user can see said plural digital images as if in a mirror. However, in the same field of endeavor, Killcommons teaches this feature (see

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col. 14, lines 56-63). At the time of the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Killcommons image magnification process into Kenet system. The suggestion/motivation for doing so would have been to provide the process of selecting percentage of zooming (see col. 13, lines 59-67).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY BITAR whose telephone number is (571)270-1041. The examiner can normally be reached on Mon-Fri (7:30a.m. to 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vikkram Bali can be reached on 571-272-7415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nancy Bitar/



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Examiner, Art Unit 2624

/Wes Tucker/

Primary Examiner, Art Unit 2624